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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Bridon *et al.*

Confirmation No.: 7359

Application No.: 10/722,733

Art Unit: 1648

Filed: November 25, 2003

Examiner: Zachariah Lucas

For: LONG LASTING SYNTHETIC
GLUCAGON LIKE PEPTIDE (GLP-1)

Attorney Docket No.: 11767-055-999
(CAM: 515319-999055)

**THIRD REQUEST FOR RECONSIDERATION OF
DECISION ON PETITION UNDER 37 C.F.R. § 1.182**

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants received from the United States Patent and Trademark Office ("USPTO") a Decision on the Second Request for Reconsideration of Decision on Petition Under 37 C.F.R. § 1.182, dated May 19, 2009 ("the May 19, 2009 Decision"). The May 19, 2009 Decision dismissed Applicants' Second Request for Reconsideration of Decision on Petition Under 37 C.F.R. § 1.182 filed on February 5, 2009 ("the February 5, 2009 Request for Reconsideration"), which requested reconsideration of the Decision on the Request for Reconsideration of Decision on Petition Under 37 C.F.R. § 1.182, dated December 19, 2008 ("the December 19, 2008 Decision"). The December 19, 2008 Decision dismissed Applicants' Request for Reconsideration of Decision on Petition Under 37 C.F.R. § 1.182 filed on October 31, 2008 ("the October 31, 2008 Request for Reconsideration"), which requested reconsideration of the Decision on Petition Under 37 C.F.R. § 1.182 dated September 2, 2008 ("the September 2, 2008 Decision"). The September 2, 2008 Decision dismissed Applicants' request made in the Petition Under 37 C.F.R. § 1.182 dated June 30, 2008 ("the June 30, 2008 Petition") that the above-identified abandoned application be amended to recite the correct relationship to a prior-filed application to which priority is claimed under 35 U.S.C. § 120. Applicants hereby request reconsideration of the May 19, 2009 Decision, and reiterate their request that U.S. Patent Application No. 10/722,733 ("the

'733 Application") be amended to indicate that the '733 application is a continuation-in-part, rather than a continuation, of prior-filed U.S. Patent Application No. 09/623,548 ("the '548 Application").

The September 2, 2008 Decision states that the '733 Application failed to make a specific reference to the prior-filed '548 Application, and that a petition under 37 C.F.R. § 1.78 (a)(3) is required, since the '733 Application was filed after November 29, 2000. Applicants responded in the October 31, 2008 Request for Reconsideration that a petition under 37 C.F.R. § 1.78(a)(3) is not necessary because a claim for the benefit of priority to the '548 Application, though not indicating the correct relationship to the '548 Application, was nonetheless included in both the Application Data Sheet (ADS) and Preliminary Amendment filed concurrently with the '733 Application on November 25, 2003, and this benefit claim was recognized by the USPTO as shown by its inclusion on the filing receipt for the '733 Application. In response, the December 19, 2008 Decision states that the priority claim made on the filing date of the '733 Application was incorrect because both the specification and the ADS stated that the present application "claims priority to US Application No. 09/623,548." The December 19, 2008 Decision further states that "the change that petitioner is attempting to make is not merely a correction of the relationship" (the December 19, 2008 Decision at page 2). Applicants responded in the February 5, 2009 Request for Reconsideration that an indication of the relationship between the '733 Application and the '548 Application was provided at the time of filing the '733 Application, in particular, on the Request to Transfer Sequence Listing which accompanied the filing of the '733 Application. In response, the May 19, 2009 Decision states that Applicants' argument with respect to a timely indication of the relationship between the '733 Application and the '548 Application is "found to be **persuasive**" (May 19, 2009 Decision at page 2, emphasis added). Nonetheless, the USPTO maintains that a petition under 37 C.F.R. § 1.78(a)(3) is required, citing CX14 of the USPTO publication entitled "Eighteenth-Month Publication Questions and Answers" (<http://www.uspto.gov/web/offices/dcom/olia/aipa/18monthfaq.htm#cx14>), which states, in relevant part, that to **add** a benefit claim of a prior-filed non-provisional application in a later-filed copending application that has been abandoned, a petition under 37 CFR 1.78(a)(3) is required if the later filed application is a utility or plant application filed after November 29, 2000 (emphasis added).

Applicants respectfully submit that the USPTO's citation of CX14 is misplaced, since CX14 relates to situations where an Applicant is **adding** a benefit claim, not correcting a timely submitted benefit claim. Applicants respectfully submit that CX6 of "Eighteenth-Month Publication Questions and Answers" should govern, since Applicants timely made a benefit claim at the time of filing of the '733 Application, as acknowledged by the USPTO in the May 19, 2009 Decision. CX6 states:

CX6. Applicant filed an application with a benefit claim to an earlier copending nonprovisional application. The benefit claim was filed within four months from the actual filing date of the application, but the relationship of the applications was designated as "continuation." If applicant wants to change the relationship to "continuation-in-part," would a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t) be required? (added 4Feb2005)

No, the petition under 37 CFR 1.78(a)(3) and the surcharge would not be required when applicant is changing the relationship in a benefit claim from "continuation" (or "divisional") to "continuation-in-part" or from "continuation-in-part" to "continuation" (or "divisional"), or from "continuation" to "divisional," because the Office was able to schedule the application for publication with the relationship given.

Since a benefit claim to the '548 application was made at the time of filing of the '733 application, and since Applicants seek to amend the '733 application to indicate that the '733 application is a continuation-in-part rather than a continuation of the '548 application, a petition under 37 CFR 1.78(a)(3) is not required. *See* also M.P.E.P 201.11(V) (page 200-70), Eighth Edition, Revision 5, August 2006.¹

Applicants respectfully submit that the USPTO has provided no basis for requiring a petition under 37 CFR 1.78(a)(3) to *correct* a timely made benefit claim merely because of the abandoned status of the application. Applicants remind the USPTO that amendment of an abandoned application to correct a priority claim is proper under *Sampson v. Commissioner*

¹ M.P.E.P 201.11 (V) states in relevant part:

A petition under 37 CFR 1.78(a)(3) and the surcharge would not be required for correcting a timely submitted benefit claim for the following situations:

(A) Changing the relationship of the applications (*e.g.*, changing from "continuation" or "divisional" to "continuation-in-part" or from "continuation-in-part" to "continuation" or "divisional"); ...


of Patents and Trademarks, 195 U.S.P.Q. 136 (D.D.C. 1976), and is properly petitionable under 37 C.F.R. § 1.182 (*see* the June 30, 2008 Petition, page 3).

In view of the foregoing, Applicants respectfully request reconsideration of the USPTO's May 19, 2009 Decision. In particular, Applicants reiterate their request to amend the '733 application to correct the priority claim to the '548 application, and for entry of the Supplemental Application Data Sheet submitted with the June 30, 2008 Petition. While not conceding the propriety of the USPTO's May 19, 2009 Decision, Applicants reserve the right to submit a petition under 37 C.F.R. § 1.78 (a)(3) to amend the priority claim to indicate that the '733 application is a continuation-in-part of the '548 Application, in the event that this third Request for Reconsideration is denied.

Applicants believe that no fee is due for this request. Should any fee be required, however, please charge such fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: July 16, 2009


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